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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,544	11/26/2003	Tony D. Wartian	2936.3001.001	9737
23399	7590	08/30/2004	EXAMINER	
REISING, ETHINGTON, BARNES, KISSELLE, P.C. P O BOX 4390 TROY, MI 48099-4390			SAKRN, VICTOR N	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/723,544	WARTIAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	VICTOR N SAKRAN	3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 26 November 2003.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-6 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-6 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 26 November 2003 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

**The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

**The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:**

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 and 2, are rejected under 35 U.S.C. 103(a) as being unpatentable over Priolo U. S. patent No. 3,076,242 in view of Simpson U. S. Patent No. 5,867,874.**

**Priolo discloses the general combination claimed of a clip comprising a base a first upwardly extending leg member (14), a second upwardly extending second leg member (15) spaced from said first leg member and a third leg member (22)**

extending upwardly from said and spaced from the first and second leg members, the first and the third leg members defining a generally U-shaped upwardly opening channel at one portion of the base and the second and the third also defining an upwardly opening channel extending from a second portion of the base and a tongue member (16) extending from the outer extremity of the second leg member (15) downwardly into the second channel in spaced relation to the second and third leg members, wherein said second leg member and the tongue member defining a generally V-shaped upwardly opening line receiving slot; see Figures 1-3; column 2, lines 1-7, and claim 1, except that the reference to Priolo use his holding clip as a clothes pin and does not provide barbs on its first and third leg members. Simpson teaches the use of a pencil holding clip formed of flexible resilient material comprising three legs defining two channels and barbs provided on two of its leg members, wherein one channel is adapted to receive the lower edge portion of a wearer's cap and the other channel for receiving a pencil; see Figures 3, 4, and the abstract. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the holding clip in Priolo from a flexible resilient material and use it to hold a pencil to a cap in the manner taught, disclosed and suggested by Simpson; especially, since such modification involves only routine skill in the art.

Furthermore, the particular use of the clip is considered to be no more than a matter of design choice obvious to one having ordinary skill in the art at the time the invention was made.

**Claims 3-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over the same references as applied to claim 1, above, and further in view of Parveris U. S. Patent No. 5,555,607 who teaches the use of a holding clip formed of a plastic material comprising a tongue member (31) extending downwardly and having steps along its length spaced different distance from the opposed leg member; see Figures 1, 2; column 5, lines 5-15, 62-67 and claim 1, and to further incorporate such structure in Priolo in the manner taught, disclosed and suggested by Parveris it would have been obvious to one having ordinary skill in the art.**

**Furthermore, Applicant is reminded that in considering the disclosure of a reference, it is proper to take into account not only specific teaching of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom; see In re Preda, 401 F2d 825, 826, 159 USPQ 342,344 (CCPA1968).**

**AS to the particular type of material used is considered to be no more than an obvious matter of design choice within the skill in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. See In Re Leshin, 125 USPQ 416.**

**The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's attention is directed to the prior art cited herein, as showing structure related to Applicant's disclosed invention.**

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR N SAKRAN whose telephone number is 703-308-2224. The examiner can normally be reached on 6:30 AM - 5:00 PM.**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. swann can be reached on 703-308-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.**

**Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).**

August 24, 2004



**VICTOR N SAKRAN  
Primary Examiner  
Art Unit 3677**